

Office Action Summary

Application No.

09/606,878

Applicant(s)

UCHIYAMA, AKIRA

Examiner

Brian K Talbot

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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The amendment filed 7/16/01 has been considered and entered. Claim 40 has been added. Claims 1-24 and 40 remain in the application.

In light of the amendment filed 7/16/01, the objection to the specification concerning the Title as well as the rejection based on a non-enabling disclosure concerning the machining step have been withdrawn.

Claim Rejections - 35 USC § 112

Claims 1-24 and 40 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for facing cases for watches made of titanium, does not reasonably provide enablement for any other titanium surface such as those for cutting tools. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. Claims should be amended to recite such a limitation, i.e. "a titanium facing case for watches".

Claim Rejections - 35 USC § 103

Claims 1-24 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted state of the art (specification, pg. 1-3) in combination with either Thoma

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(4,588,480), Rothschild et al. (4,938,850), Beaty (5,603,338), Angell (3,650,861) or Fahrmbacher-Lutz et al. (4,525,250).

Applicant's admitted state of the art (specification, pg. 1-3) teaches that watches made of aluminum or aluminum alloys covered with a transparent protective film are known. The specification further teaches that titanium and titanium alloys are known to be utilized in forming watches, however, oxidation of the titanium materials is a problem.

Applicant's admitted state of the art (specification, pg. 1-3) fails to teach removing "adhesion substances" from the titanium surfaces prior to applying the transparent protective film.

Thoma (4,588,480), Rothschild et al. (4,938,850), Beaty (5,603,338), Angell (3,650,861) or Fahrmbacher-Lutz et al. (4,525,250) all individually teach the importance of removing "native oxides, i.e. titanium oxide" and impurities on the surface of titanium prior to subsequent plating processes.

While the Examiner acknowledges the fact that the references teach a metal plating step as opposed to a transparent protective layer, i.e. glass, the references are relied upon for teaching the known "pretreatment" steps to form a "prepared clean titanium surface" prior to any subsequent coating. It is the Examiner's position that one skilled in the art would recognize that the problems associated with titanium oxide and other impurities would also effect not only metal coating but other coatings as well. Hence, it is the Examiner's position that one skilled in the art at the time the invention was made would have had a reasonable expectation of achieving similar success regardless of the type of subsequent coating.

With respect to the claimed "pretreatment steps" as well as the compositional make up of the glass layer, it is the Examiner's position that these are all "result effective" variables which can be optimized by one skilled in the art. In addition, one skilled in the art would have had a reasonable expectation of achieving similar success regardless of which conventional technique was utilized without the showing of unexpected results.

Response to Amendment

Applicant's arguments filed 7/16/01 have been fully considered but they are not persuasive.

Applicant argued that the 35 USC 112 first paragraph rejection concerning the recitation of "facing cases for watches" is traversed as the Examiner has utilized art which extends outside the realm of watches and in doing so is estopped from making the rejection.

The Examiner disagrees. The issue here is whether the specification provides enablement for titanium surfaces other than facing of watches. This is clearly not met and hence the corresponding claims should be directed toward facing cases of watches.

Appellant argued that the Examiner used improper hindsight in making the rejection.

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgement on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the

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time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K Talbot whose telephone number is (703) 305-3775. The examiner can normally be reached on Tuesday-Friday 7AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-6078 for regular communications and (703) 305-6357 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3775.



Brian K Talbot
Primary Examiner
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BKT
September 20, 2001